

## REMARKS

Applicants respectfully request reconsideration of the subject application in view of the above amendments and the following remarks.

**I. Status of the Claims.** Claims 1-6, 8-11, 13, 14, and 17-22 are pending and have been examined. Claim 1 has been amended as follows:

- (i) The text, "wherein W is C, CH or COH and the dotted lines indicate optional bonds and wherein A is a group having the formula:" has been repositioned to follow Formula (I);
- (ii) Formula (IIA) has been added following the repositioned text;
- (iii) Groups including the expressions "alk(en/yn)yl" and "cycloalk(en)yl" either alone in combination have been replaced by the particular alternative groups or combinations of groups that are defined by the respective expressions. Accordingly, the expression "C<sub>1-6</sub>-alk(en/yn)yl" has been replaced with --C<sub>2-6</sub>-alkenyl, C<sub>2-6</sub> alkynyl, C<sub>1-6</sub> alkyl--; the expression "C<sub>3-8</sub> cycloalk(en)yl" has bee replaced with --C<sub>3-8</sub> cycloalkyl, C<sub>3-8</sub> cycloalkenyl--; and the expression "C<sub>3-8</sub>-cycloalk(en)yl-C<sub>1-6</sub>-alk(en/yn)yl" has been replaced with --C<sub>3-8</sub>-cycloalkyl-C<sub>1-6</sub>-alkyl, C<sub>3-8</sub>-cycloalkyl-C<sub>2-6</sub>-alkenyl, C<sub>3-8</sub> cycloalkyl-C<sub>2-6</sub> alkynyl, C<sub>3-8</sub> cycloalkenyl-C<sub>1-6</sub>-alkyl, C<sub>3-8</sub>-cycloalkenyl-C<sub>2-6</sub> alkenyl, C<sub>3-8</sub>-cycloalkenyl-C<sub>2-6</sub>-alkynyl--; and
- (iv) The number "0" has been replace with the letter --O--.

Support for the amendment to claim 1 is found in the specification at pages 4, line 20 through page 7, line 27 and page 15, lines 25-27 (where the expression "C<sub>1-6</sub>-alk(en/yn)yl" is defined as a C<sub>1-6</sub>alkyl, C<sub>2-6</sub>-alkenyl or C<sub>2-6</sub>-alkynyl group and the expression "C<sub>3-8</sub>-cycloalk(en)yl" is defined as a alkyl C<sub>3-8</sub>-cycloalkyl- or cycloalkenyl group.) All amendments to

claim 1 are supported by the specification as filed. The amendments to claim 1 do not add new matter to the application, accordingly.

Nor do the present amendments narrow claim 1.

**II. Supplemental Oath/Declaration.** Applicants respectfully disagree with the Examiner's position that a supplemental oath/declaration is required. The present application is a divisional filed under 37 C.F.R. § 1.53(b) of serial no. 09/719,849. The application was filed with a copy of the declaration filed in the parent application. A divisional application filed under 37 C.F.R. § 1.53(b) (other than a continuation-in-part (CIP)) may be filed with a copy of the oath or declaration from the prior nonprovisional application. MPEP 602.05(a). The present application is not a CIP of serial no. 09/719,849. Accordingly, the filing of the copy of the declaration from the parent application is sufficient in this application. No supplemental oath/declaration is believed to be required.

The Examiner's reliance on MPEP 608.04(b) is believed to be misplaced. MPEP 608.04(b) is only applicable when a preliminary amendment adds new matter to the application. The preliminary amendment filed on January 15, 2002 did not add new matter to the application. Nor has the Examiner indicated that the preliminary amendment added new matter to the application. Accordingly, Applicants' position is that MPEP 608.04(b) does not apply.

**III. Claim Rejections Under 35 U.S.C. § 112, second paragraph.** Claims 1-6, 8-11, 14, and 17-22 have been rejected as allegedly indefinite. In response, without conceding the correctness of the rejections, claim 1 has been amended to address the stated reasons for the rejections, as follows. Formula (I) has been repositioned relative to the two lines that previously preceded the formula-- the formula cannot be construed as a group defined for "A." The three

paragraphs that previously appeared to refer to Formula (I) now refer to Formula (IIA). The proviso for X and Y refers to Formula (IIA), wherein X and Y are in the same ring.

The amendments to claim 1 are believed to address and overcome the stated reasons for the present rejection. Applicants respectfully request reconsideration of claims 1-6, 8-11, 14 and 17 and withdrawal of all rejections thereof under 35 U.S.C. 112, second paragraph, accordingly.

**Conclusion**

In view of the above amendments and remarks, it is respectfully requested that the application be reconsidered and that all pending claims be allowed and the case passed to issue.

If there are any other issues remaining, which the Examiner believes could be resolved through either a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

Respectfully submitted,

Dated: December 8, 2003

  
\_\_\_\_\_  
Mitchell Bernstein, Ph.D.  
Reg. No. 46,550  
Agent for Applicants

Darby & Darby P.C.  
Post Office Box 5257  
New York, NY 10150-5257  
212-527-7700